

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD J. SVETKOFF and BRIAN L. DOSS

Appeal No. 1999-0323
Application No. 08/079,504¹

ON BRIEF

Before STONER, Chief Administrative Patent Judge, HARKCOM, Vice Chief Administrative Patent Judge, and NASE, Administrative Patent Judge.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 43 and 44. Claims 1 through 42 have been allowed.

¹ Application filed June 17, 1993, for reissue of U.S. Patent No. 5,024,529 (Application No. 07/150,135, filed January 29, 1988), issued June 18, 1991.

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We REVERSE.

BACKGROUND

The appellants' invention relates to a method for the high-speed, high-resolution, 3-D imaging of an object at a vision station. An understanding of the invention can be derived from a reading of exemplary claims 43 and 44, which appear in Appendix I to the appellants' brief.

Claims 43 and 44 stand rejected as being improper reissue claims which attempt to recapture subject matter deliberately canceled from the parent application in order to obtain allowance.²

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the final rejection (Paper No. 23, mailed April 1, 1997), the advisory action (Paper No. 29, mailed August 26, 1997), and the examiner's answer (Paper No. 33, mailed February 17, 1998) for the examiner's complete reasoning in support of the rejection, and to the appellants'

² We assume that this rejection was made under the provisions of 35 U.S.C. § 251.

brief (Paper No. 32, filed November 24, 1997) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie basis for a rejection of claims 43 and 44 based on the recapture doctrine. Accordingly, we will not sustain the examiner's rejection of claims 43 and 44. Our reasoning for this determination follows.

The issue presented by the examiner and the appellants is whether the recapture doctrine is applicable in this reissue application. We agree with the appellants' arguments (brief, pp. 7-10) that the recapture doctrine is not applicable in this reissue application.

An attorney's failure to appreciate the full scope of the invention qualifies as an error under 35 U.S.C. § 251 and is correctable by reissue. In re Wilder, 736 F.2d 1516, 1519, 222 USPQ 369, 370-71 (Fed. Cir. 1984). Nevertheless, "deliberate withdrawal or amendment . . . cannot be said to involve the inadvertence or mistake contemplated by 35 U.S.C. Section 251." Haliczer v. United States, 356 F.2d 541, 545, 148 USPQ 565, 569 (Ct. Cl. 1966). The recapture doctrine, therefore, prevents a patentee from regaining through reissue the subject matter that he surrendered in an effort to obtain allowance of the original claims. See Mentor Corp. v. Coloplast, Inc., 998 F.2d 992, 995, 27 USPQ2d 1521, 1524 (Fed. Cir. 1993). Under this rule, claims that are "broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution" are impermissible. Id. at 996, 27 USPQ2d at 1525. In addition, to determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection. See Mentor, 998 F.2d at

995-96, 27 USPQ2d at 1524-25; Ball Corp. v. United States, 729 F.2d 1429, 1436, 221 USPQ 289, 294-95 (Fed. Cir. 1984).

The examiner determined (final rejection, p. 3) that claims 43 and 44 were not being proper claims in this reissue application

in that they attempt to recapture subject matter cancelled in order to have the original application allowed. The language of claim 43 that the position sensitive detector has "an area sufficiently small to keep the capacitance down so that the speed is up" is apparently an attempt to recapture subject matter prosecuted in and cancelled from the application which matured into the original patent in order to obtain allowance of that application. See MPEP 1412.02. Note also the definition of "broader" for the purposes of reissue applications in MPEP 1412.03; no claim is proper in a reissue application if that claim is broader *in any respect* than any claim cancelled to obtain allowance of the original patent.

The examiner also determined (advisory action, p. 2-3) that

[t]here were claims in the parent application that claimed "small", and the claims were amended to remove "small" and replace it with a narrower term in order to obtain allowance of that parent application. Thus applicant is estopped from obtaining claims limited to the photodetector being "small". The remarks filed 25 July 1997 argue that the claims are narrower because they have the "limitation" "sufficiently small to keep the capacitance down so the speed is up" rather than merely claiming "small". However, these extra words are

essentially meaningless; these claims do not definitely limit "small"; it is not clear what size detector would not be "small". Nor do they set forth any meaningful limitation of what "keep the capacitance down" of "the speed is up" could mean. It is unclear what, if any, capacitance would not be "down" nor what speed would not be "up". The instant specification mentions, on page 2, lines 21-25, a detector which has a detector area of 20 mm X 20 mm, with a capacitance of several hundred picofarads. It would appear that by any reasonable definition of the terms 20 mm X 20 mm could be "small" and a capacitance of several hundred picofarads would be "down". Thus, though the portion of the claim may have more words than merely "small", it does not in fact further limited [sic]. Thus the rejection has not been overcome.

The Federal Circuit in In re Clement, 131 F.3d 1464, 1468-70, 45 USPQ2d 1161, 1164-65 (Fed. Cir. 1997) set forth a three step process for determining if the recapture doctrine should be applied against claims in a reissue application.

The first step in applying the recapture doctrine is to determine whether and in what "aspect" the reissue claims are broader than the patent claims. For example, a reissue claim that deletes a limitation or element from the patent claims is broader in that limitation's aspect. The examiner has not

determined which limitations the appellants have deleted from the patent claims.

The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. To determine whether the appellants have surrendered particular subject matter, one must look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection. The examiner has not cited any prosecution history that establishes the changes to the claims in the parent application regarding the "small" size of the position sensitive detector were made in an effort to overcome a prior art rejection.

The third step is that once it is determined that the appellants have surrendered the subject matter of the canceled or amended claim, it must then be determined whether the surrendered subject matter has crept into the rejected reissue claims. Comparing the reissue claim with the canceled

claim is one way to do this.³ If the scope of the reissue claim is as broad as or broader than the canceled or amended claim in all aspects, then the recapture doctrine bars the claim. In contrast, a reissue claim narrower in scope in all aspects escapes the recapture doctrine entirely. However, if the reissue claim is broader in some aspects, but narrower in others, then: (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture doctrine bars the claim; (b) if the reissue claim is narrower in an aspect germane to prior art rejection, and broader in an aspect unrelated to the rejection, the recapture doctrine does not bar the claim.⁴ The examiner has not determined that surrendered subject matter has crept into the rejected reissue claims.

³ In re Wadlinger, 496 F.2d 1200, 1204, 181 USPQ 826, 830 (CCPA 1974).

⁴ Mentor is an example of (a); Ball is an example of (b).

Thus, the examiner has not satisfied his burden of presenting a prima facie basis for a rejection of claims 43 and 44 based on the recapture doctrine.

Furthermore, the recapture doctrine clearly does not apply to the facts of this case. In that regard, it is our opinion that the presently claimed limitation "position sensitive detector having . . . an area sufficiently small to keep the capacitance down so the speed is up" is plainly narrower in scope than the previously claimed limitation "small area position detector". Accordingly, it is clear to us the examiner's rejection of claims 43 and 44 is in error.

CONCLUSION

To summarize, the decision of the examiner to reject claims 43 and 44 is reversed.

REVERSED

BRUCE H. STONER, JR.)	
Chief Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
GARY V. HARKCOM)	APPEALS
Vice Chief Administrative Patent Judge)	
) AND)	
)	INTERFERENCES
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JEFFREY V. NASE)	
Administrative Patent Judge)	

JVN/gjh

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APPEAL NO. 1999-0323 - JUDGE NASE
APPLICATION NO. 08/079,504

APJ NASE

CAPJ STONER

VCAPJ HARKCOM

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 24 Mar 99

FINAL TYPED: